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In re Patent No. 6,919,356

Douglas G. Batt

Issue Date: July 19, 2005

Application No. 10/670,596

Filed: September 25, 2003

Attorney Docket No. 7440 NP

:
: DECISION ON
: PATENT TERM ADJUSTMENT
: AND NOTICE OF INTENT
: TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the "PETITION TO CORRECT PATENT TERM ADJUSTMENT PERIOD IN GRANTED PATENT UNDER 37 CFR 1.702(a)(4)", filed September 19, 2005. Patentee requests that the patent term adjustment indicated on the patent be corrected from zero (0) days to sixty (60) days.

The request for reconsideration of the patent term adjustment indicated on the patent is GRANTED.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **sixty (60) days**.

On July 19, 2005, the above-identified application matured into U.S. Patent No. 6,919,356. The patent issued with a Patent Term Adjustment of zero (0) days. The instant request for reconsideration filed September 19, 2005, was timely filed within two months of the date the patent issued. See § 1.705(d). Patentee fails to state whether the patent is subject to a terminal disclaimer.

The Office determined a patent term adjustment of 0 days based on an adjustment for PTO delay of 60 days pursuant to 35 U.S.C. 154(b)(1)(A)(iv) and 37 C.F.R. §1.703(a)(6), reduced by applicant's delay of 120 days pursuant to 35 U.S.C.

154(b)(2)(C)(ii) and 37 C.F.R. §1.704(c)(10). The PTO delay is not contested. The adjustment of 120 days is at issue.

The adjustment of 120 days has been found to be incorrect. With his transmittal of the issue fee, applicant filed a "Fee Address Indication Form". By Official Gazette Notice dated June 26, 2001, the Director has advised applicants and patentees that the filing of certain papers after the mailing of a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and will not result in reduction of a patent term adjustment pursuant to 37 C.F.R. §1.704(c)(10). See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance, 1247 OG 111 (June 26, 2001).

A "Change of Address" is specified as being a paper that is not considered to be "failure to engage". In this situation, it is concluded that the "Fee Address Indication Form" is analogous to a "Change of Address", and accordingly no reduction in PTA is warranted. In view thereof, the correct determination of PTA at the time of issuance is 60 days.

The \$200.00 fee set forth in 37 C.F.R. §1.18(e) has been charged to Deposit Account No. 19-3880, as authorized. Petitioner's request that this fee not be charged, as the error was ascribable to the Office, is dismissed.¹

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. §254 and 37 C.F.R. §1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **sixty (60) days** subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enc: draft Certificate of Correction (1 page)

¹ See Comment 1 in Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 1239 OG 14, 65 Fed. Reg. 54366 (Oct. 3 2000) (stating that the fee set forth in 37 C.F.R. 1.18(e) is charged to allow the Office to recover the estimated average cost of treating applications for patent term adjustment, and is not refundable even in the event of Office error).